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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,477	04/19/2007	Hartmut Fitz	095309.57860US	4945

23911 7590 06/27/2008  
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EXAMINER
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FULTON, KRISTINA ROSE

ART UNIT	PAPER NUMBER
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3673

MAIL DATE	DELIVERY MODE
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06/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,477	<b>Applicant(s)</b> FITZ ET AL.	
	<b>Examiner</b> Kristina R. Fulton	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/12/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-9 are cancelled. Claims 10-23 are rejected below.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the guide arm and the rotary bearing must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. These features are not referenced in the specification and therefore can not be found in the figures. If applicant intended to reference components described in the specification, they must consistently be named the same in the claims.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-18 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 10, 22 and 23 require a bearing arm which is never described in the specification or disclosed in the figures.
5. Claim 11 requires a rotary bearing which is never described in the specification or disclosed in the figures.
6. Claims 12-18 are rejected based on their dependency of claim 10.
7. Claim 20, "supervision" should be --suspension--.
8. The claims have been examined "as best understood"

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 10-14 and 18-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Donner (WO 2004003856).

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11. Regarding claims 10, 19 and 22, Donner shows an electronic key (1) having key housing (2) that has a suspension eyelet (4) in a region close to its periphery, the suspension eyelet having a deployed use and a stowed non-use position (see abstract), wherein the suspension eyelet is held by a guide arm (elongated arm portion of eyelet which pivots) which is mounted to the housing; the guide arm is movable such that the suspension eyelet is lowered into a receiving space in the key housing, in which it is inaccessible in its non-use position; and the suspension eyelet is movable out into the use position for the purpose of suspending the electronic key.

12. Regarding claim 11, the guide arm of the suspension eyelet is held on the key housing by means of a rotary bearing (5), such that it can pivot.

13. Regarding claims 12 and 23, the guide arm of the suspension eyelet is held on the key housing such that it can slide (figures 2 or 3). Please note that the eyelet can move in and out of the housing and therefor reads on the claim. The method of motion (pivot, slide, rotate, etc) is not considered critical and therefor not patentably distinct.

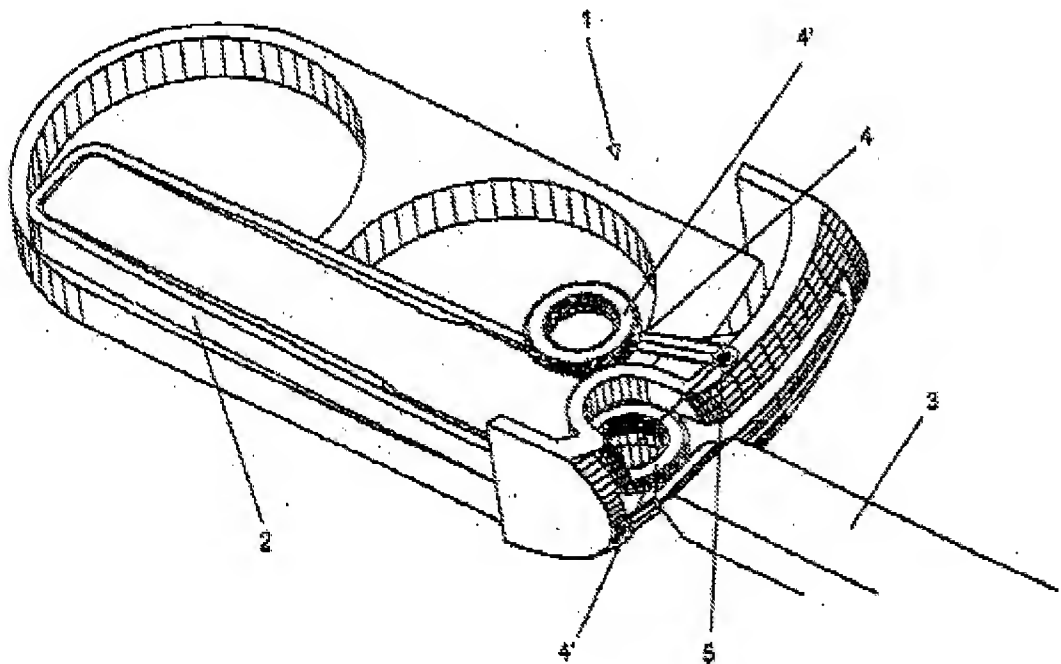
14. Regarding claims 13 and 20, the key housing has a receiving shaft for an associated mechanical key which can be inserted into the receiving shaft and can be completely withdrawn from the latter; and the suspension eyelet is automatically moved into the use position when the mechanical key is withdrawn from the receiving shaft.

15. Regarding claim 14, the mechanical key forces the suspension eyelet into its non-use position (see abstract) when the mechanical key is inserted into the receiving shaft.

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16. Regarding claim 18, the mechanical key is a flat key; the suspension eyelet has a plate-like region (figure 2 shows a plate like region) which runs substantially parallel to a broad side of the inserted flat key in a common receiving shaft of the key housing.

17. Regarding claim 21, said mechanical key has a suspension structure (overlapping the eyelet) by which the electronic key can be suspended when the suspension eyelet is in the stowed position. See the Donner device below.



***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

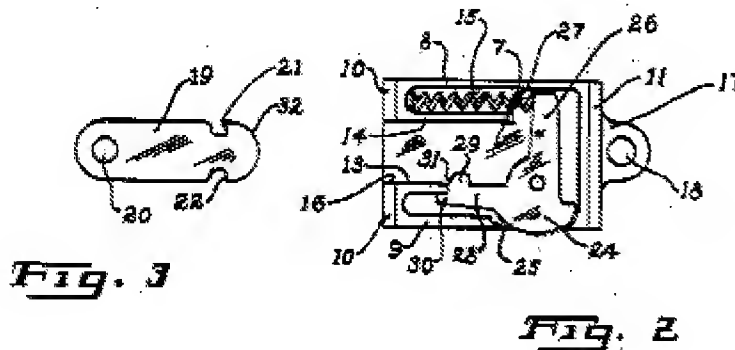
21. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Donner as applied to the claims above and further in view of Nolan (US 2694244).

Donner shows applicant's inventive concept including a suspension eyelet supported against a holding zone of the mechanical key and a bearing point of the key housing but fails to include a spring. Nolan shows that it is well known in the key art to include a spring for projecting an object from the housing. It would have been obvious to one of

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ordinary skill in the art to include a spring in the Donner device in order to assure the proper extraction of the eyelet. Adding a spring to Donner is a reasonable and obvious modification and would have yielded predictable results. See the Nolan device below.



### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristina R. Fulton whose telephone number is 571-272-7376. The examiner can normally be reached on Monday-Friday, 7am-4:30pm, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L Engle/  
Supervisory Patent Examiner,  
Art Unit 3673

/K. R. F./  
Examiner, Art Unit 3673  
6/20/08